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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,419	12/15/2000	Joshua M. Broehl	2734.0475	8779

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
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EXAMINER

DRUAN, THOMAS J

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8A

Office Action Summary	Application No. 09/736,419	Applicant(s) BROEHL, JOSHUA M.	
	Examiner Thomas J. Druan, Jr.	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group VI in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Groups I-V are all directed to the same general combination, namely a dispenser, rather than being directed to separate subcombinations disclosed as being usable in a single combination. Also, Applicant contends that there is no undue burden in searching all of the groups. This is not found persuasive because while Groups I-V are all directed towards a dispenser, the claims of Groups I-V each disclose subcombinations usable together in a single combination. For example, the specific drive means of Group II do not require the specific shield of Group III to function, and conversely, the specific shield of Group III does not require the specific drive means of Group II to function, and thus these groups represent subcombinations. Further, the drive means of Group II is usable with the shield of Group III; thus, the subcombinations are usable together in a single combination. As for the undue burden of searching all of Groups I-V, each of the Groups represents a different aspect of a dispenser that is located in a different class or subclass from the other groups, and therefore would represent an undue burden to have to find the specifics of five distinct aspects of a dispenser against at least the whole of the dispenser art. Therefore, the undue burden of searching Groups I-V exists. Regarding claim 18, it should not be specifically included as part of Group IV, though it would be part of any one of Groups I-V if any of those Groups were elected.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,924,617 to LaCount et al. (hereinafter LaCount).

LaCount discloses the invention as claimed including a method of dispensing sheet material comprising: providing a dispenser containing first (135) and second (130) sources of sheet material, the dispenser including a first rotatable roller (120) having at least one recessed portion (between segments 121) and a second rotatable roller (105) having at least one raised portion (110), the second roller having a retainer (115); dispensing sheet material from the first source by passing the sheet material between the first and second rollers (fig. 8 & column 6, lines 12-15); retaining, in the retainer on the second roller, an end portion of the sheet material from the second source (column 5, lines 52-62); limiting rotation of the second roller by contacting the raised portion of the second roller against the sheet material between the first and second rollers (column 6, lines 12-15); placing the second roller in contact with the first roller when sheet material from the first source is no longer between the first and second rollers; and rotating the second roller to thereby feed sheet material from the second source onto the first roller to permit dispensing of sheet material from the second source

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(column 6, lines 53-59). The dispenser includes a third rotatable roller (100) forming a nip with said first roller, and wherein the method further includes passing sheet material through the nip (column 6, lines 61-64).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaCount in view of US 119,235 to McDonald (hereinafter McDonald).

LaCount discloses the invention substantially as claimed, but retains the sheet material from the second source in a circumferential slot and a clip instead of a slot passing completely through the roller. McDonald teaches the use of a slot through a roller to securely retain sheet material. Therefore, it would have been obvious to one skilled in the art to substitute the retainer of LaCount with the retainer of McDonald for the step of retaining since they are art-recognized equivalents for retaining sheet members in rollers, and the slot of McDonald would include fewer removable parts than that of LaCount, and would therefore be simpler to operate.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson et al., Morand et al., Haen et al., Jespersen '533, and Craven Jr. are cited to further show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

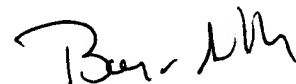
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ag/dq

tjd

February 10, 2003



**BOYER ASHLEY
PRIMARY EXAMINER**